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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,932	03/05/2002	Toyohiro Kobayashi		7255

7590 04/15/2004

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JAPAN

EXAMINER

MORAN, KATHERINE M

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 04/15/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,932

Applicant(s)

KOBAYASHI, TOYOHIRO

Examiner

Katherine M Moran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/24/03, 3/5/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment of 1/30/2004 has been received and reviewed. Applicant also submitted a request for continued examination on 1/30/2004. The amendment of 1/30/2004 cancelled claims 4 and 5, amended claims 1, 2, and 3, and included a substitute specification which will not be entered into the case. Currently, claims 1-3 and 7 are pending.

Claim Objections

2. Claim 3 is objected to because of the following informalities: lines 3-4: delete "by means for connecting, line 5: delete "materials" and insert --material--. Appropriate correction is required.

Specification

3. The substitute specification filed 1/30/04 has not been entered because it does not conform to 37 CFR 1.125 because: the submission does not include a statement that the substitute specification does not include new matter.

4. The disclosure is objected to because of the following informalities: Pages 2 and 3 (Brief Description of the Drawings) and page 6, lines 7-8 recite that Figures 6-8 illustrate a hood with a sunshade cover. This is inconsistent and unclear because the remainder of the paragraph recites a headband with a sunshade cover.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites "both-sided hook and loop". Please clarify what is meant by "both-sided"?

7. Claim 7 is indefinite because it is unclear how the cap body is "formed in a headband". If the Applicant is intending to recite a headband in place of a cap body, how is the cover stored by the headband when the cover is rotated for storage as recited in claims 1 and 3? Since a headband is illustrated in the drawings, claim 7 will be treated on the merits as reciting a headband in combination with the neck cover.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hujar et al. (Hujar, U.S. 5,557,807) in view of Benedict (U.S. 5,956,759). Hujar discloses the invention substantially as claimed. Hujar teaches a cap 1 comprising a cloth body, and a sunshade cover 23 including a pocket 19 for receiving ice or other coolants. The cover 23 is removably

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connected to the body by a connecting means 22, and is capable of being stored in the hat body. Column 7, lines 26-29 recite the connecting means as being selected from a variety of fasteners including snap fasteners or hook and loop fasteners. Snaps inherently include an axle portion projecting from the male piece for connecting to the female portion, thereby allowing for removal and rotation of the cover in relation to the cap. It is well known in the art that various types of fastening mechanisms are functionally equivalent. The snaps allow for the cover to be rotated and stored inside the cap body, and rotated out of the cap body for cooling the back part of the wearer's nape and head. However, Hujar does not teach cooling material which is a water-absorbing material as a fiber obtained by processing a polymer that contains the sodium salt of polyacrylic acid as a major component, provided to the sunshade cover. Benedict '759 teaches a cap 10 with cooling means 45 composed of a modified acrylic polymer which absorbs large quantities of water, whereby the liquid evaporates to cool the wearer. Further, the specification contains no disclosure of either the critical nature of the claimed polymer or any unexpected results arising from its use, and that as such the claimed polymer is arbitrary and therefore, obvious. Such unsupported material cannot be a basis for patentability since where patentability is said to be based upon the cooling material's composition, the applicant must show that the elements of the cooling material are critical. Therefore, it would have been obvious to one of ordinary skill in the art to provide the cover 23 of Hujar with the cooling material which is a water-absorbing fiber obtained by processing a polymer that contains the sodium salt of polyacrylic acid as a major component since this is an inexpensive, commercially available composition which can undergo many cycles of adsorption and evaporation without degradation.

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10. Claim 7, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Hujar '807 in view of Benedict '759 and further in view of Koritan (U.S. 5,046,195). Hujar, when viewed with Benedict as outlined above, discloses the invention substantially as claimed. However, Hujar does not teach a cap body formed in a headband with elasticity. Koritan teaches a headband 12 with elasticity in combination with a neck cover 10. The neck cover is attached to the headband via hook and loop 13,15. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the cap body formed in a headband with elasticity, because this embodiment allows for improved air circulation since the top of the wearer's head is exposed.

Response to Arguments

11. As pointed out in Applicant's arguments, the advisory action of 1/30/04 indicated that claim 3 would be allowable if rewritten to include the suggested claim language. However, upon further review, it is determined that claim 3 does not clearly recite the novel embodiment described in the specification. This embodiment is drawn to the combination of the stopper pin/axle and the hook and loop positioned on the cap and on the sunshade cover. If claim 3 were amended to include this combination, as well as the objections outlined above under the Claim Objections heading, claim 3 would recite novel patentable subject matter.

Applicant's arguments with respect to claims 1-3 and 7 have been considered but are moot in view of the new grounds of rejection.

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Conclusion

12. Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (703) 305-0452. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (703) 305-1025. The official fax number for the organization where this application is assigned is (703) 872-9302. The after final fax number for this organization where this application is assigned is (703) 872-9303.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist at (703) 308-1148.

Kmm

April 12, 2004



Katherine Moran

Primary Examiner

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